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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/744,595

01/26/2001

Kojiro Okamoto

0819-416

1644

7590

10/28/2004

Nixon Peabody
Suite 800
8180 Greensboro Drive
McLean, VA 22102

EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT

PAPER NUMBER

2655

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,595

Applicant(s)

OKAMOTO ET AL.

Examiner

Jorge L Ortiz-Criado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lokhoff et al. U.S. Patent No. 5,060,219 in view of Timmermans et al. U.S. Patent No. 5,930,210.

Regarding claim 1, Lokhoff et al. discloses a disk-shaped recording medium comprising (See col. 6, lines 20-22):

a primary recording region (See Fig. 3a, 3e)

and a secondary recording region which is located on the side of an internal periphery of said primary recording region (See Fig. 3a, 3c),

wherein said primary recording region has a track which wobbles at a first pitch and along which a user is able to record a data signal (See col. 6, lines 33-35; Fig. 3a, 3e);

and wherein said secondary recording region has a track which wobbles at a second pitch different from said first pitch or does not wobble (See Fig. 3a, 3c),

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and along information pits are formed to record signal representative of control information as data (See col. 2, lines 50-58; Fig. 3a, 3c).

Lokhoff et al. further discloses a control information in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium (See col. 1, lines 40-55; col. 2, lines 50-58; Fig. 3a, 3c)

Lokhoff et al. does not expressly disclose wherein said control information in said secondary recording region includes, an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region.

However this feature is well known in the art as evidenced by Timmermans et al., which discloses a recording medium which includes, as data, an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region (See col. 7, lines 1-16);

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to provide a control information prerecorded in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium as teaches by Lokhoff et al. and further includes an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region as suggested by Timmermans et al, in order to prohibit illegal copies of the disk, as suggested by Lokhoff et al. and Timmermans et al.

Regarding claim 13, the combination of Lokhoff et al. and Timmermans et al. as modified above would show said control information is prerecorded at the time of manufacture of said recording medium (See Lokhoff et al. col. 1, lines 40-55; col. 2, lines 50-58; Fig. 3a, 3c)

Regarding claim 14, the combination of Lokhoff et al. and Timmermans et al. as modified above would show control information includes an identification information item representative of the type of said recording medium (See Timmermans et al., col. 7, lines 1-16).

Regarding claim 15, the combination of Lokhoff et al. and Timmermans et al. as modified above discloses all the limitations based on claim 12 as outlined above and would show A reproducing apparatus for reproduction of main data recorded in said primary recording region of said recording medium (See Timmermans et al. col. 5, lines 13-25; Figs. 1a, 1b, 1c, 3, 5), said reproducing apparatus comprising:

a pickup for reading a signal from said recording medium under rotation (See Timmermans et al. col. 5, lines 30-34; Fig. 5, Ref# 52)

means for shifting said pickup (See Timmermans et al. col. 5, line 53 to col. 6, line 1-56; Fig. 5 Ref# 60)

means for distinguishing if a reproduction location of said recording medium is the track which wobbles as said first pitch or the track which wobbles at said second pitch different from said first pitch or does not wobble (See Timmermans et al. col. 5, line 53 to col. 6, line 1-56; Fig. 5 Ref# 60);

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wherein the case where according to said means for distinguishing the reproduction location of said recording medium, the reproduction location is said primary recording region having said track pitch which wobbles at said first pitch, and the main data encrypted in said primary recording region are being recorded, said pickup is shifted to said secondary recording region by said means for shifting said pickup (See Timmermans et al. col. 5, line 53 to col. 6, line 1-56; Fig.5 Ref# 60),

and the reproduction of the main data encrypted in said primary recording region is inhibited by the invalid key information item included in said control information in said secondary recording region (See Timmermans et al. col. 6, line 45 to col. 7, line 21; Fig. 5,Ref# 61,62)

Regarding claim 16, the combination of Lokhoff et al. and Timmermans et al. as modified above would show means for spinning said recording medium at a constant linear velocity (See col. 5, lines 28-30; lines 63-65; Fig. 5, Ref. #50)

wherein the case where according to said means for distinguishing the reproduction location of said recording medium, the reproduction location is said track pitch which wobbles at said second pitch or does not wobble and the reproduction of the main data encrypted in said primary recording region is terminated by a key information item included in said control information obtained from a means for obtaining said control information (See Timmermans et al. col. 6, line 45 to col. 7, line 21; Fig. 5,Ref# 61,62)

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Regarding claim 17, the combination of Lokhoff et al. and Timmermans et al. as modified above would show means for spinning said recording medium at a constant linear velocity (See Timmermans et al. col. 5, lines 28-30; lines 63-65; Fig. 5, Ref. #50)

means by which a signal read position by said pickup follows said tracks of said recording medium (See Timmermans et al. col. 5, lines 34-60; Fig. 5, Ref# 55),

means for generating a tracking error signal from an output of said pickup (See Timmermans et al. col. 5, lines 34-60; Fig. 5, Ref# 56), and

means for starting reproduction of said main data recorded in said primary recording region (See Timmermans et al. col. 6, line 45 to col. 7, line 21; Fig. 5, Ref# 61,62)

Regarding claim 18, the combination of Lokhoff et al. and Timmermans et al. as modified above would show control information includes an identification information item representative of the type of said recording medium (See Timmermans et al., col. 7, lines 1-21), and

wherein said reproducing apparatus further comprises means for canceling when said identification information item indicated that recording of data signal into said primary recording region by user is possible and, in addition, main data recorded in said primary recording region is encrypted, reproduction of said main data (See Timmermans et al. col. 6, line 45 to col. 7, line 21; Fig. 5, Ref# 61,62)

Regarding claim 19, the combination of Lokhoff et al. and Timmermans et al. as modified above would show, means for continuing when main data recorded in said primary recording

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region is not encrypted, reproduction of said main data (See Timmermans et al. col. 6, line 45 to col. 7, line 21; Fig. 5, Ref# 61,62)

Regarding claim 20, the combination of Lokhoff et al. and Timmermans et al. as modified above would show wherein said control information includes de-cryption information (See Timmermans et al. col. 6, line 45 to col. 7, line 21; Fig. 5, Ref# 61,62)

Response to Arguments

3. Applicant's arguments filed 06/04/2004 have been fully considered but they are not persuasive.

Applicant's response to the rejection of claims 12,13 and 20 as unpatentable over Lokhoff et al. in view of Timmermans et al.

Applicant argued that Lokhoff et al. does not teach or suggest a second recording region having a track

“along which information pits area formed to record a signal representative of control information... wherein said control information...includes... an invalid key information item... for inhibiting reproduction of main data in the primary recording region.”

Applicants argued that Lokhoff et al. alone does not teach or suggest certain features as claimed in claim 12.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lokhoff et al. in view of Timmermans et al.

Lokhoff et al. further discloses a control information in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium (See col. 1, lines 40-55; col. 2, lines 50-58; Fig. 3a, 3c)

Lokhoff et al. does not expressly disclose wherein said control information in said secondary recording region includes, an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region and this feature is well known in the art as evidenced by Timmermans et al., which discloses a recording medium which includes, as data, an invalid key information item for inhibiting/enabling/disabling reproduction of main data encrypted in said primary recording region (See col. 7, lines 1-16);

Applicants argued that Timmermans does not disclose an **“invalid information item for inhibiting reproduction of main data encrypted”**. Also argued that the cited portion of Timmerman’s discloses only a de-encryption code and the code is not the same as claimed “invalid key information item” which inhibits reproduction.

The Examiner cannot concur because Timmermans et al. discloses an “invalid key information item for inhibiting /not-enabling/enabling/disabling reproduction of main data encrypted”, Timmermans et al. discloses recovering the invalid key/code from the secondary

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recording region and compare this invalid key/code to inhibit/enabling/disabling the reproduction of the encrypted data and in addition further preferably include a de-encryption key code for decrypt the main data encrypted (col. 6, line 45 to col. 7, line 21).

Applicants argued that Timmermans et al. or Lokhoff et al. does not teach or suggest of “information pits are formed ”.

The Examiner cannot concur because, Lokhoff et al. discloses secondary recording region has a track which wobbles at a second pitch different from said first pitch or does not wobble, in which pattern of pits are recorded (as shown in Fig. 3a, 3c; col. 6, lines 20-35) including a control information in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium (See col. 1, lines 40-55; col. 2, lines 50-58; Fig. 3a, 3c) and the combination of Lokhoff et al. with Timmermans et al. shows “invalid key/code information item for inhibiting /not-enabling/enabling/disabling reproduction of main data encrypted”, as teaches by Timmermans et al. (see Timmermans et al. col. 6, line 45 to col. 7, line 21).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one with ordinary skill in the art at the time of the invention to provide a control information prerecorded in said secondary recording region for indicating which type(s) of information is copied into said primary recording region for inhibit if it detected to be of a type indicated by the control information being read from the recording medium as teaches by Lokhoff et al. an further includes an invalid key information item for **inhibiting reproduction of main data encrypted in said primary recording region** as suggested by Timmermans et al, in order to prohibit illegal copies of the disk, which is a well know problem that both Lokhoff et al. and Timmermans et al. are present as an object of their inventions.

Applicant's response to the rejection of claims 15-19, as unpatentable over Lokhoff et al. in view of Timmermans et al.

Applicants argued that the combination specifically Timmermans et al. does not teach or suggest, "in a case where according to said means for distinguishing the reproduction location of said recording medium, the reproduction location is said primary recording region having said track pitch which wobbles at said first pitch, and the main data encrypted in said primary

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recording region are being recorded, said pickup is shifted to said secondary recording region by said means for shifting said pickup and the reproduction of the main data encrypted in said primary recording region is inhibited by the invalid key information item included in said control information in said secondary recording region

The Examiner cannot concur, because Timmermans et al. discloses distinguishing if a reproduction location of said recording medium is the track that wobbles as said first pitch or the track that wobbles at said second pitch different from said first pitch or does not wobble, (see col. 6, lines 12-49) and maintaining shifting/scanning the pickup until the wobbles at said second pitch different from said first pitch of the secondary recording region is detected (See col. 6, lines 45-56). In the case of the detection of said second pitch different from said first pitch of the secondary recording region the recovery of the information recovery is enable, which includes an invalid key/code information item for inhibiting/enabling/disabling reproduction of the encrypted main data and after and a comparison/detection of the invalid key/code information item the reproduction of the main data encrypted in the primary recording region is inhibited/enabled/disabled. (See col. 6, line 45 to col. 7, line 21)

Conclusion

This is a continuation of applicant's earlier Application No. 09/744,595. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L Ortiz-Criado whose telephone number is (703) 305-8323. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm), Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris H To can be reached on (703) 305-4827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUSAN MCFADDEN
PRIMARY EXAMINER